

REMARKS

Claims 44-89 are pending in the Application and all stand rejected in the final Office action mailed May 11, 2010. Claims 44, 63, and 71 have been amended, claims 58, 64, and 85 have been cancelled, and new claims 90-98 have been added. Claims 44, 63, and 71 are independent claims from which claims 45-62 and 90-92, 64-70 and 93-95, and 72-89 and 96-98 depend, respectively. Applicants respectfully request reconsideration of pending claims 44-57, 59-63, 65-84, and 86-89, and consideration of new claims 90-98, in light of the remarks set forth below.

The Applicants note that a goal of patent examination is to provide a prompt and complete examination of a patent application.

It is essential that patent applicants obtain a prompt yet complete examination of their applications. Under the principles of compact prosecution, each claim should be reviewed for compliance with every statutory requirement for patentability in the initial review of the application, even if one or more claims are found to be deficient with respect to some statutory requirement. Thus, USPTO personnel should state all reasons and bases for rejecting claims in the first Office action. Deficiencies should be explained clearly, particularly when they serve as a basis for a rejection. Whenever practicable, USPTO personnel should indicate how rejections may be overcome and how problems may be resolved. **A failure to follow this approach can lead to unnecessary delays in the prosecution of the application.**

M.P.E.P. §2106(II) (emphasis added).

As such, the Applicants assume, based on the goals of patent examination noted above, that the current Office Action sets forth “all reasons and bases” for rejecting the claims.

Rejections of Claims

Claims 44, 48-50, 53-56, 61, 63, 64, 67, 68, 71, 75-77, 80-83, and 88 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Israel, *et al.* (US 4,723,238, hereinafter "Israel") in view of Suffern, *et al.* (US 5,724,413, hereinafter "Suffern"). Claims 45, 46, 51, 52, 65, 66, 72, 73, 78, and 79 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Israel in view of Suffern and Row, *et al.* (US 5,163,13, hereinafter "Row"). Claims 47, 57-60, 69, 74, and 84-87 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Israel in view of Suffern in view of Flanagan (US 4,100,377). Claims 62, 70, and 89 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Israel in view of Suffern and Messenger (US 5,046,066). Applicants respectfully traverse the rejections for the reasons set forth during prosecution, and those that follow. Applicants respectfully note that all of the rejections over art are for reasons of alleged obviousness.

Applicants first review what is required to support a rejection under 35 U.S.C. §103. According to M.P.E.P. §2142, "[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness." (emphasis added) M.P.E.P. §2142 further states that "[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious." As recognized in M.P.E.P. §2142, "[t]he Supreme Court in *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007), 82 USPQ2d 1385, 1396 noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit." In addition, the Federal Circuit has made clear that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR*, 127 S. Ct. 1727 (2007), 82 USPQ2d at 1396.

In addition, as noted in the Manual of Patent Examining Procedure (Revision 7,

July 2008), “[t]o establish *prima facie* obviousness of a claimed invention, **all the claim limitations** must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).” See MPEP §2143.03. Further, “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.’ *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA).” *Id.*

Thus, the law is clear that words of a claim cannot be merely disregarded during examination. Instead, all the words in a claim must be considered during the examination process.

Further, in *Ex parte Hiyamazi*, the Board of Patent Appeals and Interferences reversed a rejection based on a combination of references, stating, in part:

Under 35 USC § 103, where the Examiner has relied upon the teachings of several references, the test is whether or not the reference viewed individually and collectively would have suggested the claimed invention to the person possessing ordinary skill in the art. Note *In re Kaslow*, 707 F.2d 1366, 107 USPQ 1089 (Fed.Cir. 1983). **It is to be noted, however, that citing references which merely indicate the isolated elements and/or features recited in the claims are known is not a sufficient basis for concluding that the combination of claimed references would have been obvious.** That is to say, there should be something in the prior art or a convincing line of reasoning in the answer suggesting the desirability of combining the claimed invention. Note *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed.Cir. 1986).

Ex parte Hiyamazi, 10 USPQ2d 1393, 1394 (Bd. Pat. App. & Interf. 1988) (emphasis added).

I. The Proposed Combination Of Israel And Suffern Does Not Render Claims 44, 48-50, 53-56, 61, 63, 64, 67, 68, 71, 75-77, 80-83, and 88 Unpatentable

Claims 44, 48-50, 53-56, 61, 63, 64, 67, 68, 71, 75-77, 80-83, and 88 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Israel in view of Suffern. Applicants respectfully traverse the rejection.

With regard to independent claim 44, Applicants respectfully submit that claim 44 has been amended to include aspects of claim 58, so that claim 44 now recites, in part, “[a] method for communicatively coupling a packet network to at least one communication network having an associated information format, the method comprising: ... establishing call communication between the packet network and the at least one communication network based upon the configuration information, the communication including the conversion of information received in a packet format for transmission in the associated format, and the conversion of information received in the associated format for transmission in the packet format, wherein the conversion of information received in a packet format for transmission in the associated format comprises buffering digitized voice information for a period of time to minimize gaps in a voice signal.” Independent claim 71 has been amended in a manner similar to claim 44. Applicants respectfully submit that claims 44 and 71 were rejected over the same art for the same reasons. Claims 58 and 85 were also rejected over the same art for the same reasons. Applicants respectfully submit that the proposed combination of Israel, Suffern, and Flanagan does not teach, suggest, or disclose at least the aspects of Applicants’ claims 58 and 85 now recited by 44 and 71, respectively, and that the art cited in the rejections of claims 58 and 85 does not render amended claims 44 and 71, or any of the claims that depend from claims 44 and 71, unpatentable.

The Office rejects the subject matter of claims 58 and 85 at pages 10-11 of the Office action, stating:

For claim 58 and 85, Israel in view of Suffern does not teach the method of claim 44 and 71 wherein the conversion of information received in a packet format for transmission in the associated format comprises buffering digitized voice information for a period of time to minimize gaps in a voice signal. However, Flanagan teaches balancing silent interval lengths, talkspurt delivery times and receive buffer lengths with the intelligibility of the delivered speech (Flanagan: col. 2 lines 10-24). It would have been obvious to one having ordinary skill in the art to modify Israel and Suffern with Flanagan's teaching in order to balance buffer size with voice quality.

Applicants appreciate recognition by the Office that Israel and Suffern do not teach Applicants' claims 44 and 71. The Office then relies upon Flanagan at col. 2, lines 10-24. Applicants now review the cited portion of Flanagan, including the paragraph at col. 1, line 66 to col. 2, line 9, which immediately precedes the cited text at col. 2, lines 10-24. The portion of Flanagan at col. 1, line 6 to col. 2, line 9 is reproduced below:

In accordance with the illustrative embodiment of the present invention, speech signals are detected in talkspurt lengths and such talkspurts are encoded. The encoded talkspurts are buffered in a temporary storage medium with the intertalkspurt silent intervals deleted. Each talkspurt is associated with a time stamp indicating the time of initiation of that particular talkspurt. When a sufficient number of talkspurts have been assembled to provide an optimally-sized packet, this packet competes for the use of the common transmission facilities and is assigned to such facilities when they become available.

The portion of Flanagan shown above teaches that "speech signals" are detected as "talkspurts" separated by intervals of silence, and are encoded. Each encoded "talkspurt" is buffered and associated with a "time stamp" indicating the time of the start of that "talkspurt." The "silent intervals" between "talkspurts" are deleted. The "talkspurts" are then packetized, and the "optimally sized packet" competes with others for use of "common transmission facilities." The cited portion of Flanagan at col. 2, lines 10-24 recites the following:

At the receiving end of the transmission facility, the talkspurt packets are again buffered. Using the time stamps, the talkspurts can be delivered from the receiving buffer at times approximately corresponding to their generation. The coded talkspurts are then decoded and delivered to a listener as intelligible speech. In accordance with one feature of the present invention, the lengths of the silent intervals, and hence the delivery time of each talkspurt, can be varied over a considerable range without seriously affecting the intelligibility of the delivered speech. This leeway in talkspurt delivery time can be effectively used both to substantially

reduce the size of the receiving buffer and to increase the efficiency of the use of the common transmission facilities.

The portion of Flanagan shown above, which was specifically selected by the Office, teaches that the “talkspurt packets” are buffered at the receiver, and that “talkspurts” are delivered from the buffer “at times approximating their generation.” The “coded talkspurts” are then decoded and delivered to a listener as intelligible speech. Flanagan explains that the length of the “silent intervals” and therefore the delivery time of each “talkspurt” can be varied (i.e., from that of the original speech signal and therefore as indicated by the timestamps of the “talkspurts”) “without seriously affecting the intelligibility of the delivered speech.” Flanagan further teaches that “this leeway in talkspurt deliver time” can be effectively used to “reduce the size of the receiving buffer” and to “increase the efficiency of the use of the common transmission facilities.” Applicants respectfully submit that the cited portion of Flanagan does not, however, teach, suggest, or disclose “wherein the conversion of information received in a packet format for transmission in the associated format comprises buffering digitized voice information for a period of time to minimize gaps in a voice signal,” as required by the language of claim 58, now recited by claim 44. This is true for a number of reasons.

The Office asserts that “Flanagan teaches balancing silent interval lengths, talkspurt delivery times and receive buffer lengths with the intelligibility of the delivered speech,” but fails to provide the “explicit analysis” required by M.P.E.P. §2142 to explain how such alleged teachings of Flanagan actually teach, suggest, or disclose the specific features of Applicants’ claim 58. The Office fails to specifically identify any of the elements or actions of Flanagan as teaching the individual features of claim 58 now recited by Applicants’ claim 44. **Applicants respectfully request, should the Office maintain the rejection of these aspects of claim 44, that the Office specifically identify for each element of Applicants’ claim 44 the corresponding teaching in the cited art, identifying the element and figure, col. or paragraph and line, and include a clear and detailed explanation explaining how and why the Office is**

interpreting the cited portion(s) of the art as teaching each of Applicants' claim elements.

To the extent that the Office may be interpreting the "silent interval" of Flanagan as corresponding to Applicants' claimed "gap[] in a voice signal," Applicants respectfully submit that the cited portion of Flanagan teaches varying the delivery time of each "talkspurt" and thereby varying the length of the "silent interval" between "talkspurts." Even if Applicants were to agree that the "silent interval" of Flanagan teaches Applicants' claimed "gap[] in a voice signal," **which Applicants do not**, Flanagan does not teach, suggest, or disclose buffering digitized voice information for a period of time to minimize a "silent interval." Applicants respectfully submit that "varying" may be increasing or decreasing, and even if taken as decreasing would not teach "minimizing," as required by the language of claim 58 now part of claim 44. Indeed, the portion of Flanagan cited by the Office fails to make any mention of minimizing anything, let alone minimizing a "silent interval" between "talkspurts."

To whatever extent the Office may be suggesting that the packetization and transmission of "talkspurts" over a "common transmission facility" by Flanagan teaches minimizing "gaps in a voice signal," Applicants respectfully submit, first, that Flanagan teaches strives to "increase the efficiency of the use of the common transmission facilities." *Id.* at col. 2, lines 20-24. (emphasis added) Applicants also respectfully submit that any alleged teaching of minimizing gaps within a "talkspurt packet" or between "talkspurt packets" on the "common transmission facility" is quite different from and does not teach, suggest, or disclose "minimizing gaps in a voice signal." This is so for at least the reason that the packetized "talkspurts" transmitted across the "common transmission facility" are all not part of a (singular) voice signal, but are from different speakers of different voice calls. See, e.g., FIG. 1 and col. 2, line 65 to col. 3, line 49. Further, Applicants respectfully submit that the cited portion of Flanagan fails to make any mention of a "gap" within a "talkspurt," nor does Flanagan therefore teach anything with respect to minimizing such untaught "gaps." Therefore, Applicants respectfully submit that packetization and transmission of "talkspurts" over a "common transmission

facility” as taught by Flanagan does not teach, suggest, or disclose Applicants’ claimed “minimizing gaps of a voice signal,” let alone minimizing such “gaps of a voice signal.”

Therefore, for at least the reasons set forth above, Applicants respectfully submit that the Office has not demonstrated that Flanagan remedies the admitted deficiency of Israel and Suffern, namely, the failure of Israel and Suffern to teach Applicants’ claim feature “wherein the conversion of information received in a packet format for transmission in the associated format comprises buffering digitized voice information for a period of time to minimize gaps in a voice signal.” Because Israel and Suffern admittedly do not teach at least this aspect of claim 58 now recited by claim 44, and Applicants have shown that Flanagan also does not teach this aspect now included as part of claim 44, it necessarily follows that the proposed combination of Israel, Suffern, **and** Flanagan cannot, by definition, teach at least this feature now recited by Applicants’ claim 44. Applicants respectfully submit that the Office has therefore not shown that the cited art teaches all aspects of Applicants’ amended claim 44, that amended claim 44 is not rendered unpatentable by the cited art, and that claim 44 as amended, and any claims that depend from claim 44, are allowable over the cited art.

With regard to claim 50, Applicants respectfully submit that the Office rejects claim 50 at page 4, stating the following:

For claim 50 and 77, Israel teaches the method of claim 44 and 71 wherein the at least one communication network is a second packet network (Israel: may establish calls between PSS terminals, col. 2 line 55).

Thus, the Office identifies only Israel and only at col. 2, line 55 as teaching Applicants’ claim 50.

Initially, Applicants respectfully submit that claim 50 depends from independent claim 44. Applicants respectfully submit that claim 44 is allowable over the proposed combination of references, for at least the reasons set forth above with respect to claim 44. Applicants respectfully submit that claim 50 is allowable for at least an additional reason.

Applicants respectfully note that claim 44 now recites, in part, “[a] method for communicatively coupling a packet network to at least one communication network having an associated information format, the method comprising: ... establishing call communication between the packet network and the at least one communication network based upon the configuration information, the communication including the conversion of information received in a packet format for transmission in the associated format, and the conversion of information received in the associated format for transmission in the packet format, wherein the conversion of information received in a packet format for transmission in the associated format comprises buffering digitized voice information for a period of time to minimize gaps in a voice signal.” Thus, Applicants’ claim 44 requires establishment of “communication” between a “packet network” and “at least one communication network” separate from the “packet network,” and that the “communication” includes “conversion of information received in a packet format for transmission in the associated format, and the conversion of information received in the associated format for transmission in the packet format.”

In the rejection of claim 44, the Office identifies “data converter 145X” of FIG. 1 of Israel as teaching Applicants’ claimed “conversion.” See Office action at page 3. The Office cites Israel at col. 2, line 55 as teaching Applicants’ claim 50. The cited portion of Israel, however, recites the following:

The PSS may be a well-known local area network, such as an AT&T Starlan network, which includes a group of network access units (NAU) 132-1 through 132-M. Terminals 131-1 through 131-M communicate via NAU 132-1 through 132-M, respectively, to establish calls between themselves over packet (CSMA) bus 133 of the PSS. The NAUs compete with each other for access to packet bus 133. Packet system interface (PSI) 134 provides access to other packet switched systems. The operation of the Starlan network NAU is described in "The STARLAN Network Technical Reference Manual" (999-300-208IS), published by AT&T.

The portion of Israel show above teaches that “[t]erminals 131-1 through 131-M communicate via NAU 132-1 through 132-M, respectively, to establish calls between

themselves over packet (CSMA) bus 133 of the PSS." (emphasis added) Notably, Israel fails to teach that "data converter 145X" is involved in any way, and thus fails to teach Applicants' claimed "conversion." In addition, Applicants respectfully submit that the Office has identified the "PSS 13" and "CSS 12" of FIG. 1 as teaching Applicants' claimed "packet network" and "at least one communication network," respectively. See *id.* at page 3. Applicants respectfully submit that the asserted "calls between PSS terminals" would necessarily be within the "PSS 13," which has been identified by the Office as corresponding to Applicants' claimed "packet network" and would not even involve the "CSS 12" identified by the Office as teaching Applicants' claimed "at least one network." The "calls between PSS terminals" cannot therefore teach Applicants' claim 50, which requires that the "at least one communication network" (as opposed to the "packet network" recited by claim 44 and therefore part of claim 50) is "a second packet network." Therefore, Applicants respectfully submit that Israel fails to teach, suggest, or disclose, at least, "wherein the at least one communication network is a second packet network," as recited by claim 50, and that claim 50 is independently allowable over the cited art for at least these additional reasons.

Based at least upon the above, Applicants respectfully submit that the Office has not shown that the cited art teaches all aspects of amended claim 44, and therefore has not established a *prima facie* case of obviousness, as required by M.P.E.P. §2142 and §2143.03. Applicants respectfully submit that claim 44 is therefore not rendered unpatentable by the cited art, and that claim 44, and any claims that depend therefrom, are allowable over the proposed combination of Israel and Suffern.

With regard to independent claim 71, Applicants respectfully submit that claims 44 and 71 were rejected over the same art for the same reasons, and have been amended to include similar features of claims 58 and 85, respectively. Applicants respectfully submit that amended claim 71 is therefore allowable over the cited art for at least some of the reasons set forth above with respect to amended claim 44.

With respect to claim 77, Applicants respectfully submit that claims 50 and 77 were rejected over the same art for the same reasons, and that Applicants have shown

that claim 50 is allowable. Therefore, Applicants believe that claim 77 is also allowable over the cited art for at least some of the reasons set forth above.

With regard to independent claim 63, Applicants respectfully submit that claim 63 has been amended so that it now recites features similar to claims 44 and 71, that claim 63 is rejected over the same art as claims 44 and 71, and that claim 63 is therefore allowable over the cited art for at least some of the reasons set forth above.

Based at least upon the above, Applicants respectfully request that the rejections of claims 44, 63, and 71, and their respective dependent claims 48-50, 53-56, 61, 64, 67, 68, 75-77, 80-83, and 88 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

II. The Proposed Combination Of Israel, Suffern, and Row Does Not Render Claims 45, 46, 51, 52, 65, 66, 72, 73, 78, And 79 Unpatentable

Claims 45, 46, 51, 52, 65, 66, 72, 73, 78, and 79 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Israel in view of Suffern and Row. Applicants respectfully submit that claims 45, 46, 51, and 52, claims 65 and 66, and claims 72, 73, 78, and 79 depend, respectively, from independent claims 44, 63, and 71. Applicants respectfully submit that claims 44, 63, and 71 are allowable over the proposed combination of references in that the Office has not shown that Row overcomes the admitted and demonstrated shortcomings of Israel and Suffern, discussed above. Because claims 44, 63, and 71 are allowable over the cited art, Applicants respectfully submit that claims 45, 46, 51, 52, 65, 66, 72, 73, 78, and 79 that depend from claims 44, 63, and 71 are also allowable over the proposed combination of Israel, Suffern, and Row for at least the same reasons. Accordingly, Applicants respectfully request that the rejection of claims 45, 46, 51, 52, 65, 66, 72, 73, 78, and 79 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

III. The Proposed Combination Of Israel, Suffern, And Flanagan Does Not Render Claims 47, 57-60, 69, 74, And 84-87 Unpatentable

Claims 47, 57-60, 69, 74, and 84-87 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Israel in view of Suffern in view of Flanagan. Applicants respectfully submit that claims 47 and 57-60, claim 69, and claims 74 and 84-87 depend, respectively, from independent claims 44, 63, and 71. Applicants respectfully submit that claims 44, 63, and 71 are allowable over the proposed combination of references in that the Office has not shown that Flanagan overcomes the admitted and demonstrated shortcomings of Israel and Suffern, set forth above. Because claims 44, 63, and 71 are allowable over the cited art, Applicants respectfully submit that claims 47, 57-60, 69, 74, and 84-87 that depend from claims 44, 63, and 71 are also allowable, for at least the same reasons. Accordingly, Applicants respectfully request that the rejection of claims 47, 57-60, 69, 74, and 84-87 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

IV. The Proposed Combination Of Israel, Suffern, And Messenger Does Not Render Claims 62, 70, And 89 Unpatentable

Claims 62, 70, and 89 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Israel in view of Suffern and Messenger. Applicants respectfully submit that claims 62, 70, and 89 depend, respectively, from independent claims 44, 63, and 71. Applicants respectfully submit that claims 44, 63, and 71 are allowable over the proposed combination of references in that the Office has not shown that Messenger overcomes the admitted and demonstrated shortcomings of Israel and Suffern, set forth above. Because claims 44, 63, and 71 are allowable over the cited art, Applicants respectfully submit that claims 62, 70, and 89 that depend from claims 44, 63, and 71 are also allowable over the proposed combination of Israel, Suffern, and Flanagan, for at least the same reasons. Accordingly, Applicants respectfully request that the rejection of claims 62, 70, and 89 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

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Newly Added Claims

New claims 90-98 have been added. Claims 90-92, 93-95, and 96-98 depend, directly or indirectly, from claims 44, 63, and 71, respectively. Applicants respectfully submit that support for claim 90-98 may be found, for example, at pages 282 to 285 of the Application. Applicants respectfully submit that new claims 90-98 do not add new matter, and are allowable for at least the reasons set forth above.

Conclusion

In general, the Office Action makes various statements regarding the claims of the Application and the cited references that are now moot in light of the above. Thus, Applicants will not address such statements at the present time. However, Applicants expressly reserve the right to challenge such statements in the future should the need arise (e.g., if such statements should become relevant by appearing in a rejection of any current or future claim).

The Applicants believe that all of the pending claims are in condition for allowance. Should the Examiner disagree or have any questions regarding this submission, the Applicants invite the Examiner to telephone the undersigned at (312) 775-8000.

A Notice of Allowability is courteously solicited.

The Commissioner is hereby authorized to charge any fees required by this submission to the Deposit Account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

Respectfully submitted,

Dated: August 11, 2010
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